

10/849,978

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AUG 10 2006****REMARKS**

The remainder of this Amendment is set forth under appropriate subheadings for the convenience of the Examiner.

Interview Summary

Applicants' Attorney, Steven G. Davis, and Applicants' Agent, Booyong S. Lim, again would like to thank Examiner Raymond K. Covington and Examiner Thomas Mckenzie for the telephonic interview on August 1, 2006 and the subsequent telephonic interview on August 9, 2006 for the above-identified application.

During the interview on August 1, 2006, as summarized in the Interview Summary PTOL-413 of August 3, 2006 and in the Reply/Response to Interview Summary filed on August 4, 2006, an agreement was reached that: the rejection under 35 U.S.C. § 112, 2nd paragraph and the double patenting rejections would be withdrawn; and method claims would be allowed upon an amendment to the claims to limit the method claims to treating breast cancer.

Although it was initially agreed that the proposed amendment to the method claims would be made via Examiner's Amendment, during the subsequent interview on August 9, 2006, it was agreed that Applicants would file an Amendment in response to Office Action to effectuate the proposed amendment. The claim amendments and arguments presented herein are substantially the same as those discussed during the interview of August 1, 2006.

Amendments to the Claims

Claim 14 is currently amended to recite breast cancer. Support for this amendment can be found in the specification, for example, in Example 11 on pages 46 through 49. Although independent Claim 14 is now limited to treating breast cancer to expedite the prosecution of the present application, it is noted that Applicants do not hereby abandon or waive any rights in the canceled subject matter.

No new matter has been added.

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Claim Rejection under 35 U.S.C. § 112, second paragraph

Claims 3-13 and 16-26 are rejected under 35 U.S.C. § 112, second paragraph as being indefinite. The Examiner specifically stated that the term "alkyl or aryl group" for R2 lacks antecedent basis.

As discussed during the interview of August 1, 2006, Claims 3-13 and 16-26 depend from independent Claim 1 directly or indirectly. Claim 1 recites "aryl group" and "aliphatic group" for R2. It is noted that the term "aliphatic group" includes "alkyl," as described on page 10, lines 14-22 of the specification. As such, Claims 3-13 and 16-26 are definite, particularly pointing out and distinctly claiming the subject matter which Applicants regard as his invention. Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw this rejection.

Claim Rejection under 35 U.S.C. § 112, first paragraph

Claims 14-26 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement.

As agreed with the Examiner during the interview of August 1, 2006, independent Claim 14 has been amended to limit to treating breast cancer. Support for treating breast cancer can be found in the specification, for example, in Example 11 on pages 46 through 49. Therefore, as summarized in the Interview Summary of August 3, 2006, currently-presented independent Claim 14 and Claims 15-26 dependent therefrom meet the enablement requirement of 35 U.S.C. § 112, first paragraph. Accordingly, Applicants respectfully request reconsideration and withdrawal of this rejection.

Double Patenting Rejections

Claims 1-26 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over Claims 1-42 of U.S. Patent No. 6,861,436. Also, Claims 1-26 are provisionally rejected under the judicially created doctrine of double patenting over Claims 23-43 of copending U.S. Application No. 10/388,332.

A Terminal Disclaimer with respect to U.S. Patent No. 6,861,436 was filed in the application on March 22, 2005. For the convenience of the Examiner, a copy of the previously-filed Terminal Disclaimer is enclosed herewith

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With respect to U.S. Application No. 10/388,332, Applicants' claimed invention of the present application is patentably distinct from the subject matter of the currently-pending claims of the U.S. Application No. 10/388,332. In particular, as shown in the Amendment filed on August 9, 2006, the claims of U.S. Application No. 10/388,332 have been amended to delete -C(=O)-, -C(=S)-, -C(=N-OR)- and -C(=N-R)- from Y of its structural formula (I). In contrast, the compounds recited in the claims of the present application require -C(=O)-, -C(=S)-, -C(=N-OR₁₂)- or -C(=NR₁₂)- at the position corresponding to Y.

Therefore, Applicants respectfully request reconsideration and withdrawal of these rejections.

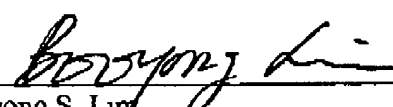
CONCLUSION

In view of the above amendments and remarks, it is believed that all pending claims are in condition for allowance, and it is respectfully requested that the application be passed to issue. If the Examiner feels that a telephone conference would expedite prosecution of this case, the Examiner is invited to call the undersigned.

Respectfully submitted,

HAMILTON, BROOK, SMITH & REYNOLDS, P.C.

By


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Dated:

August 10, 2006

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DOCKET NO 3211.1004-021TERMINAL DISCLAIMER TO OBVIATE A DOUBLE PATENTING
REJECTION OVER A PRIOR PATENT

In re Application of Keizo Koya, Lijun Sun, Mitsunori Ono, Weiwen Ying and Hao Li
Application No. 10/849,978
Filed May 20, 2004
Confirmation No 8629
For 1-GLYOXYLAMIDE INDOLIZINES FOR TREATING CANCER

COPY

The owner, Synta Pharmaceuticals Corp. of 100 percent interest in the instant application hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the instant application, which would extend beyond the expiration date of the full statutory term defined in 35 U.S.C. 154 to 156 and 173, as presently shortened by any terminal disclaimer, of prior Patent No. 6,861,436. The owner hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and the prior patent are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors or assigns.

In making the above disclaimer, the owner does not disclaim the terminal part of any patent granted on the instant application that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. 154 to 156 and 173 of the prior patent, as presently shortened by any terminal disclaimer in the event that it later: expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 CFR 1.321, has all claims cancelled by a reexamination certificate, is reissued, or is in any manner terminated prior to the expiration of its full statutory term as presently shortened by any terminal disclaimer.

The terminal disclaimer fee under 37 CFR 1.20(d) is enclosed.

The undersigned is empowered to act on behalf of the owner.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true, and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

March 21, 2005
Date

Wendy E Rieder
Signature

Wendy Rieder
Typed or printed name

Synta Pharmaceuticals Corp.
Name of Corporation

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Docket No. 3211.1004-021

STATEMENT UNDER 37 C.F.R. § 3.73(b)Inventors: Keizo Kova, LiJun Sun, Mitsunori Ono, Weiwen Ying and Hao LiApplication No./Patent No. 10/849,978 Filed/Issue Date May 20, 2004For: 1-GLYOXYLAMIDE INDOLIZINES FOR TREATING CANCER

Synta Pharmaceuticals Corp. a corporation
(Name of Assignee) (Type of Assignee, e.g., corporation, partnership, university, government agency, etc.)

states that it is

- A. ☒ the assignee of the entire right, title and interest in the patent application identified above; or
- B. ☐ an assignee together with [] of the entire right, title and interest in the patent application identified above.

The right, title and interest of the above-named assignee in the patent application identified above is established by virtue of:

- A. ☒ An assignment from the inventor(s) of the patent application identified above. The assignment was recorded in the Patent and Trademark Office at Reel 013743 Frame 0063-0066, or a copy thereof is attached.

OR

- B. ☐ A chain of title from the inventor(s) of the patent application identified above, to the current assignee as shown below.

1. From: _____ To: _____
The document was recorded in the United States Patent and Trademark Office at Reel _____, Frame _____, or a copy thereof is attached.
2. From: _____ To: _____
The document was recorded in the United States Patent and Trademark Office at Reel _____, Frame _____, or a copy thereof is attached.
3. From: _____ To: _____
The document was recorded in the United States Patent and Trademark Office at Reel _____, Frame _____, or a copy thereof is attached.

☐ Additional documents in the chain of title are listed on a supplemental sheet.

The undersigned (whose title is supplied below) is authorized to act on behalf of the assignee.

Signature: Wendy RiederName: Wendy RiederTitle: Vice President, IP and Legal AffairsDate: March 21, 2005

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